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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 09/886,444 | 06/21/2001 | Richard Lynn Gardner JR. | 10004958-1 | 5764 |

7590 11/24/2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

BROWN, KHALFD

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/886,444 | GARDNER ET AL. | |
| | Examiner Khaled Brown | Art Unit 2877 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extension of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed if the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 August 2003 and 17 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 6-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 June 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

References Cited (PTO-892)
 Artsperson's Patent Drawing Review (PTO-948)
 Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .

4) Interview Summary (PTO-413) Paper No(s) _____ .
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4,6-14,16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas, III et al (US 6091563).

Re clm 1: Thomas, III et al discloses an automated imaging system comprising: an illumination source (34), a phosphorescent imaging target (20) affixed to an object used in normal operation (10); and an optical imaging sensor (36) for receiving luminance information emitted from said phosphorescent imaging target.

Re clm 2:a processor (44)

Re clms 3,10,11: illumination source moves in relation to said phosphorescent imaging target (inherent in "scanner" Col 2 lines 44-45)

Re clm 4: the phosphorescent imaging target is movable in relation to said illumination source (the disk cartridge 10 is inserted into the disk drive)

Re clm 6: the received luminance information determines a position of said object (detected information indicates that the disk cartridge is in the disk drive)

Re clms 7,13,14: received luminance information determines an alignment of said object with another object (the disk cartridge is aligned with the disk drive col 4 line 29-31)

Re clam 8:illuminance information determines a presence of said object (inherent)

Re clms 9,12: the method of automatically imaging an object comprising the steps of: radiating photonic illumination onto said object, wherein said object is used in normal operation, scanning said object; re-radiating a portion of said radiated photonic illumination from a phosphorescent target on said object; and receiving said re-radiated photonic illumination (col 2 lines 41-55)

Re clam 15: incrementing a counter (inherently being performed by microprocessor 44)

Re clam 16: an imaging system for opto-electrically detecting a presence of an object, said imaging system comprising: means for illuminating a region of space using a small-intensity illumination source (34); means for providing a phosphorescent indicium on said object (20); and means for detecting light energy re-radiated from said phosphorescent mark (36)

Re clam 17:means for processing presence information responsive to said detected light energy (44)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, III et al (US 6091563).

Re clms 18,19: Thomas, III et al discloses an imaging system as noted above which has a means for processing presence information, means for determining positional orientation and means for aligning (44). However, Thomas, III et al does not disclose a separate means for determining positional orientation and means for aligning. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a separate means for determining positional orientation and means for aligning to improve robustness, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Nerwin v. Erlichman, 168 USPQ 177, 179.

Response to Arguments

Applicant's arguments with respect to claims 1-4 and 6-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khaled Brown whose telephone number is 703-306-5738. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 703-308-4881. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

KB
November 7, 2003



Frank Font
Supervisory Patent Examiner
Art Unit 2877